

REMARKS

This amendment is responsive to the final office action mailed May 5, 2005. Independent claims 1, 21, 40, 41, 56, and 77 have been amended to place the application in condition for allowance. Entry of the amendments, and reconsideration and allowance of all pending claims is respectfully requested. The currently pending claims are 1-54 and 56-78.

All pending claims stand rejected under 35 U.S.C. 103(a) as being obvious over Boyce (U.S. Patent 5,899,939) in view of Boyd (U.S. Patent 6,206,923). This rejection is respectfully traversed in light of the claims amendments and reasons set forth below, and as presented in Applicant's prior response filed February 2, 2005, which is incorporated herein by reference. The Examiner's rejection collectively addresses all pending claims without differentiation as to specific claim terminology differences regarding the limitation "members" (e.g., tubular, circular, annular, or ring-shaped members). Applicants' response below similarly addresses the rejection in a collective manner.

To more clearly define the claimed invention and not for reasons related to overcoming the prior art, independent claims 1, 21, 40, 41, 56, and 77 have been similarly amended without narrowing the claims to clarify that the claims recite a "nested" implant, which was already described by the limitations of these claims before the current amendment. Accordingly, this does not raise new issues requiring further search. The Examiner's attention is respectfully directed to Applicants' FIGS. 1G, 1H, 1I, 1J, and 1K and the specification from page 12, line 35 to page 16, line 9, which variously discloses the subject matter of these claims.

Independent claims 1, 21, 40, 41, 56, and 77 require an implant that is structured from two or more tubular, circular, annular, or ring-shaped members that are nested together. These members are all further described by the claims as having an outer member with an opening therein that accepts another inner member to form the nested implant. Nothing in Boyce or Boyd teaches or reasonably suggests, either alone or in combination, a nested implant as recited by independent claims 1, 21, 40, 41, 56, and 77.

Boyce discloses bone implants formed from substantially square or rectangular laminated planar sheets of bone which may be machined into various sizes and forms. Although Boyce may teach that such square or rectangular sheets may be machined into a "cylindrically shaped

bone implant” that may have a cavity (*see* Col. 6, lines 11-18), there is no teaching or suggestion whatsoever in Boyce of a nested implant as variously claimed that includes two or more tubular, circular, annular, or ring-shaped members nested together. And Boyd does not make up the deficiencies of Boyce.

As shown in FIG. 9, Boyd describes a “ring-shaped bone segment having an internal cavity (*see* Col. 6, lines 9-19). However, Boyd similarly does not teach or suggest a nested implant that includes two or more tubular, circular, annular, or ring-shaped members nested together. Therefore, even if one were to combine the teachings of Boyce and Boyd, the resulting implant would still not be the nested implant required by Applicants’ independent claims 1, 21, 40, 41, 56, and 77 which is clearly distinguishable over the cited references. To establish a *prima facie* case of obviousness, “all claim limitations must be taught or suggested by the prior art.” MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)) (emphasis added). And “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP 2143 (citing *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

Moreover, the “question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP 2141.02 (citing *Statoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530 (Fed. Cir. 1983) (emphasis in original). Considering the invention as a whole, the nested implant recited by independent claims 1, 21, 40, 41, 56, and 77 advantageously overcomes the problem of the inefficient use of a limited supply of allograft bone segments which are harvested from cadavers (*see* Applicants’ specification page 5, lines 1-19). These available allograft bone segments often lack the proper size and shape required by the patient’s bone graft needs. By machining and combining two or more tubular, circular, annular, or ring-shaped bone segments of differing dimensions as taught by the Applicants, an implant of proper size for the patient can be created. Accordingly, this is believed to represent a significant advance in the art.

For the foregoing reasons and claim amendments, independent claims 1, 21, 40, 41, 56, and 77 are believed to be in condition for allowance. All remaining pending claims depend directly or indirectly from these independent claims and are also believed to be allowable for at

least the same reasons and in view of the additional limitations added by these dependent claims which further distinguish over the prior art.

CONCLUSION


In light of the foregoing, Applicant respectfully requests reconsideration and submits that the pending claims are now allowable. Entry of the amendments is therefore respectfully requested. If the Examiner does not agree with the allowability of all pending claims, the Examiner is invited to kindly call the undersigned attorney at 212-309-6375 to resolve any remaining issues and expedite allowance of the application.

Respectfully submitted,

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